

## REMARKS

Claims 1-3, 6, 14-16, 18-23, 41-47 and 51-57 are currently pending. In the March 19, 2004 Office Action, Claims 1-2, 14-16, 18-23, 47, and 51-53 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bateman et al., U.S. Patent No. 5,884,032 (“Bateman ‘032”) in view of Bannister et al., U.S. Patent No. 6,430,282 (“Bannister ‘282”).

In addition, Claims 41-43, 45-46 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Gerszberg et al., U.S. Patent No. 6,226,362 (“Gerszberg ‘362”). Claims 15 and 44 stand rejected under 35 U.S.C. § 112, second paragraph due to various alleged insufficiencies. Additionally, Claims 3, 6, and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Finally, Claims 54-57 are allowed.

Applicants have reviewed the March 19, 2004 Office Action and the cited references and respectfully submit that the cited references fail to teach or suggest all of the elements of Applicant’s presently claimed invention. Applicants respectfully traverse the rejections and request favorable reconsideration in view of the following remarks.

### **I. Applicants’ Presently Claimed Invention**

Applicants’ previously amended Independent Claims 1, 20, 41, 51, and 53 to further clarify certain aspects of Applicants’ presently claimed invention. Applicants’ presently claimed invention is generally directed to a system and method for advertising using data network telephone connection. In particular, the present invention relates to a system and method for providing advertisement services for a plurality of subscribed merchants over a telephony network. (Applicants’ Specification, p. 2 lines 6-8).

As Applicants explain with reference to Figure 1, one example of an advertising data network includes a commercial message server 120 that is connected to the data network 106. The commercial message server 120 transports commercial messages to voice communications devices 108a, 108b. A plurality of commercials from a plurality of merchants are stored in a commercial message database 122. (Applicants' Specification, p. 15 lines 8 - 17).

The first and second voice communication devices 108a and 108b typically may include a voice input, a voice output and voice processing system (described in Applicants' Specification with respect to Figure 2B). The voice processing converts voice sound from the voice input to digital data signals that are communicated on a voice connection over the data network. The voice processing also converts digital data signals received from the voice connection to voice sound at the voice output. The voice communication devices 108a and 108b typically may include a central processing unit and memory to store and process computer programs. Each voice communication device 108a and 108b typically includes a unique network address, such as an IP address, in memory to uniquely identify it to data network 106 and permit data packets to be routed to the device. (Applicants' Specification p. 13 at lines 21-31).

The commercial message server 120 may be used by a telephony service provider to offer advertisement for revenue services to merchants. The merchants may be subscribers of telephony services from the service provider and user advertisement services an option. Advertisements that a merchant may want to have transported for display on voice communication devices may be stored in the advertisement database. (Applicants' Specification, p. 15 lines 22 - 26).

In one arrangement, a service provider host 160 is used by the cable network service provider to provide various services such as Internet access, telephony service and advertisement

services. In order to provide such services, the service provider host 160 may include a telephony connection server 150 connected to a user database 152, an advertisement service 180, a commercial message server 120 and a commercial message database 122. (Applicants' Specification, p. 24 lines 5-11).

5           The ISP can configure the commercial message server 120 and database 122 by storing commercial messages for subscribing merchants. The advertisement service 180 manages access to the commercial messages to transport the messages to users at data network telephones. The commercial messages are displayed on the display of data network telephones that are parties to telephone calls having voice over data channels. The commercial messages may also include  
10   speed dial messages that assign the merchant's user identifier to a speed dial key on the data network telephone. (Applicants' Specification, p. 24 lines 23-28).

          The service provider at the host 160 may provide advertising services to merchants using the commercial message server 120. Merchants may subscribe to advertising service from the service provider providing opportunities for added revenues to the service provider. The  
15   merchants may obtain their own commercial messages, or they may work with the service provider to configure suitable commercial messages. (Applicants' Specification, p. 29 lines 23-27).

          The commercial messages include image and/or text data composed as advertisements of the products and/or services of the subscriber merchants. The image and/or text data is  
20   transported to data network telephones 208, 218 for display on the telephone display device 116. (Applicants' Specification, p. 29 line 28 to p. 30 line 6).

          In one arrangement, the data network telephones 208a, 208b are Ethernet phones comprising telephones that include an Ethernet communications interface for connection to an

Ethernet port. The Ethernet phones in Figure 2A support the Internet Protocol (IP), using an IP address that is either statically configured or obtained by access to a Dynamic Host Configuration Protocol (DHCP) server. (Applicants' Specification p. 18, lines 3-7).

Importantly, to establish a telephone call, Applicants explain that the data network  
5 telephone receives the commercial messages before voice signals are communicated. (emphasis added). For example, after receipt of the request, the telephony connection server 150 sends the connection information 270 to the commercial message server 120. The commercial message server 120 responds with a merchant's commercial message 272. For example, the connection information 270 may include the user identifier of User A. The commercial message server may  
10 then determine that User B is a subscriber merchant and respond by sending User B's commercial messages. (Applicants' Specification, p. 30 line 26 to p. 33 line 2).

The data network telephone 218 responds with a response message (not shown in Figure 3A) to the telephony connection server 150. The telephony connection server 150 receives the response message and attaches the merchants' commercial message 272 received from the  
15 commercial message server 120 to the response message 272 received from the commercial message server 120 to the response message before sending the response message to User A's data network telephone 208 as shown at 282. In one preferred embodiment, the merchant's commercial message 272 may be inserted in the message body of the response to a REQUEST to INVITE message in accordance with the SIP protocol. (Applicants' Specification, p. 31 line 3-  
20 12) (emphasis added).

Applicants' currently pending Independent Claims are generally directed to such a network and/or system embodiments. For example, Independent Claim 1 expressly recites that a first data network telephone is "operable to receive the commercial messages before the first and

second data network telephones communicate voice signals on the voice over data channel.”

(emphasis added). All of the remaining currently rejected Independent Claims 20, 41, 47, 51, 52, and 53 contain similar language. More specifically, Independent Claim 20 recites the step of “receiving the at least one commercial message at the first data network telephone before completing the telephone call between the first data network telephone and the second data network telephone.” (emphasis added)

Independent Claim 41 recites a commercial message server that is “operable to send the commercial message to the voice communications device in use by the at least one party identified by the user identifier prior to communicating voice signals to the voice communications device.” (emphasis added)

Independent Claim 47 expressly recites a telephony connection server that communicates “the commercial messages in the telephone message prior to the telephone call.” (emphasis added).

Independent Claim 51 expressly recites a commercial message server that “uses the connection information message to send a commercial message to the user identifier prior to completion of the telephone call.” (emphasis added)

Independent Claim 52 expressly recites that a network telephony connection server that is “operable to initiate a selected data communications channel and to send the commercial messages in the response message to at least one of the voice communications devices.” (emphasis added).

And Independent Claim 53 recites a memory for storing commercial messages that includes “connection to a data network to transport the commercial messages to a plurality of

voice communications devices upon receiving connection information for the voice communications devices. (emphasis added).

Applicants respectively submit that none of the cited references, either separately or in combination, teach or suggest the step of communicating or sending a commercial message between voice communicating devices “before the first and second data network telephones communicate voice signals on the voice over data channel” (emphasis added). Therefore, none of the cited references, separately or in combination, teach or suggest Applicants’ presently claimed inventions as expressly recited in Independent Claims 1, 20, 41, 47, 51, 52, and 53.

## II. 35 U.S.C. § 103(a) REJECTIONS

Independent Claims 1, 14, 20, 41, 47, and 51 stand rejected under 35 U.S.C. § 103(a) as being allegedly anticipated by Bateman ‘149 nor Bannister ‘282. Applicants respectively traverse.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference or combine reference teachings, and this teaching or suggestion to make the claimed combination must be found in the cited references, not in Applicant’s disclosure. In addition, the cited reference or combined references must teach or suggest all the claim limitations. (M.P.E.P. § 2143).

Bateman ‘032 neither teaches nor suggests all of the limitations of Applicants’ presently claimed invention. More specifically, Bateman ‘032 does not teach or suggest transmitting a “commercial message” to either a “data network device” (Independent Claims 1 and 2) or a “voice communications device” (Independent Claims 41, 47, 51, 52, and 53).

Unlike Applicants’ presently claimed invention, Bateman ‘032 is directed to a system for accessing remote information network services such as those of the WWW. (Bateman ‘032

Abstract). Bateman '032 describes, with reference to Figures 1 and 2, a typical session. This purported typical session starts when a customer 2 calls via its Internet access line 6 into the WWW server 28 and commences a self-serve session with an organization which subscribes to Customer Contact Channel Changer service (box 2-1). The customer browses through information regarding products and services with the graphical WWW browser. This browsing is often achieved by viewing HTML pages 53 and associated multimedia files 52. There may be on-line help with addresses some questions which may arise. At some point additional details or assistance are needed and the customer chooses a "Live Help" option from within an HTML page (box 2-2). (Bateman '032, Col. 6, lines 1 – 14).

Bateman '032 explains that this may be done by using a mouse to click on a "Live Help" button on the screen, or by entering a command at the keyboard. This prompts an additional HTML form 54 to pop up which the customer must fill in (box 2-3). The form 54 asks the caller for the phone number at which they can be reached at that time. In one embodiment, the customer also has an option of specifying a preferred time to be called back with the default being to request call back as soon as possible.

The March 19, 2004 Office Action relies on Column 6, lines 8-13, 61-65 of Bateman '032 as purportedly teaching a first data network telephone "operable to receive . . . (downloaded commercial messages) before the first and second data network telephones communicate voice signals on the voice over data network." (July 31, 2003 Office Action at p. 4) (emphasis added).

Applicants respectively traverse.

These cited portions of Bateman '032 merely discuss how a customer can send a completed HTML via a computer off to the WWW server 28 where it is received by the NTTP server 46 and time stamped as shown in Figure 2. However, Figure 2 clearly illustrates that it is

the customers' computer 4 that generates the WWW browser and HTML form 54, not the telephone 8. Moreover, as Bateman '032 explains, the "telephone 8" is a plain old, traditional telephone. Specifically, Bateman '032 describes that "a telephone 8 connected to the PSTN (public switched telephone network) 9 via a telephone line." (Bateman '032 Col. 5 lines 7-9).  
5 More importantly, this purported typical session must first establish a phone call. As Bateman '032 explains, the typical session "starts when a customer 2 calls via its Internet 6 access line 6 into the WWW server 28 and commences a self-serve session with an organization." (Bateman '032 Col. 6 lines 3-5).

The cited portions of Bateman '032, therefore, do not teach or suggest transmitting  
10 "commercial messages" to a "voice communication device." Consequently, Bateman also '032 fails to teach or suggest transmitting "commercial messages" to a voice communication device or data network telephone before establishing the telephone call.

Bannister '282 fails for similar reasons. First, Bannister '282 is not even remotely directed systems and/or methods for advertising, let alone systems and/or methods for  
15 advertising using data network telephone connection. Rather, Bannister '282 is generally directed to method and apparatus for originating a voice call between a first and a second voice terminals. (Bannister Abstract).

The March 19, 2004 Office Action relies on Col. 7, lines 37-45 of Bannister '282 as  
20 "teach[ing] downloading HTML home pages to data terminals." (March 19, 2004 Office Action at p. 4). Without conceding that Bannister '282 teaches such "downloading," Applicants respectively contend that Bannister '282 does not teach or suggest transmitting "commercial messages" to a voice communication device or data network telephone before establishing the



telephone call. Consequently, neither Bateman '032 nor Bannister '282 teach nor suggest all of the limitations of Applicants' presently claimed invention.

## II. 35 U.S.C. § 102(e) REJECTIONS

Claims 41-43, 45-46 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Gerszberg et al., U.S. Patent No. 6,226,362 ("Gerszberg '362"). Applicants respectively traverse.

To anticipate a claim, "each and every element set forth in the claim [must be] found, either expressly or inherently described, in a single . . . reference." *Vergall Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (M.P.E.P. Section 2131). Applicants respectively submit that Gerszberg '362 fails teach or suggest all the claim limitations of Applicants' presently pending claims.

As discussed above, Applicants' currently pending Independent Claims recited that Applicants' commercial messages are communicated and displayed before a telephone call. (August 28, 2003 Response p. 6). Gerszberg '362 does not teach, either expressly or inherently, at least this limitation of Applicants' presently claimed invention.

Rather, Gerszberg '362 appears to be generally directed to a video enabled answering machine having, among other things, features such as a customized video announcement message. (Gerszberg '362 Abstract). Gerszberg '362 explains that the video phone answering machine can direct a calling party (*i.e.*, potential customers) to specific resources in the corporation after the call has been established. Gerszberg '362 states that

The NSP 36, ISD 32, and/or video phone 130 may host a multimedia announcement answering machine which is specifically adapted for corporations and which may direct a calling party to specific resources within the corporation.

(Gerszberg '362 Col. 8 lines 4 – 6) (emphasis added). Consequently, the video enable answering machine disclosed and taught in Gerszberg '362 does not direct “a calling party” to “specific resources” unless a call has already been established. Such a conclusion naturally follows since Gerszberg '362 is generally directed to a video phone answering machine: a machine that answers an incoming phone call.

Consequently, Gerszberg '362 does not teach a first data network telephone operable to receive commercial messages while communicating voice signals as data packets as expressly claimed in Applicants' presently pending Independent Claim 41 and 45.

The Office Action relies on Gerszberg '362 Col. 10, lines 6-11 and Col. 9, lines 1-6 for allegedly teaching a “commercial server, 36, being operable to download the commercial messages to the voice communicating device in use by the at least one party identified by the user identifier prior to communicating voice signals to the voice communication device.” (July 31, 2003 Office Action at p. 3) (emphasis added). Applicants respectively traverse.

The cited portions of Gerszberg '362 merely appear to reiterate that there first must be an established “calling party” before any type of “message” is conveyed. This is further evident by the fact that Gerszberg '362 states that the arrangement illustrated in Figure 5 detects the presence of the calling party before presenting any type of “corporate message”:

[A] system at the calling party's location such as an ISD attached video phone and/or a private branch exchange (PBX), may detect the presence of the video enabled phone . . . and present the calling party with a corporate message.

(Gerszberg '362 Col. 8 lines 60-65). Therefore, cited portions of Gerszberg '362 do not teach or suggest transmitting commercial messages “prior to communicating voice signals.”

### III. CLAIM OBJECTIONS

Claims 15 and 44 stand rejected under 35 U.S.C. § 112, second paragraph due to various alleged insufficiencies. Applicants have clarified claim and therefore respectively request withdrawal of this claim objection.

### IV. SUMMARY

Applicants respectfully submit that, in view of the remarks above, the present application is in condition for allowance and solicit action to that end. Independent claims 1, 20, 41, 47, 51, 52, and 53 are allowable for at least the reasons discussed above. Dependent claims 2-3, 6, 14-16, 18-19, 21-23, and 42-46 all depend from either Independent Claims 1, 20, 41, 47, 51, 52, or 53 and are therefore allowable for at least the reasons set forth above.

If there are any matters that may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact Applicants' undersigned representative at (312) 913-0001.

Respectfully submitted,

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